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PATENT

Case Docket No. AMAZON.012A1

Date: May 12, 2004

Page 1

In re application of : Bezos, et. al.
Appl. No. : 09/377,447
Filed : August 19, 1999
For : Computer Services For
Assisting Users In Locating
And Evaluating Items In An
Electronic Catalog Based
On Actions Performed By
Members Of Specific User
Communities
Examiner : James H. Zurita
Art Unit : 3625

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Appeal Brief - Patents, Commissioner for
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May 12, 2004

(Date)

Ronald J. Schoenbaum, Reg. No. 38,297

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Sir:

Transmitted herewith in triplicate is a Supplemental Appeal Brief to the Board of Patent Appeals.
Also enclosed are:

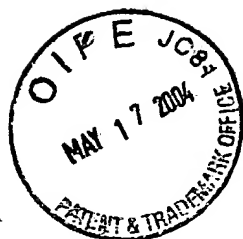
(X) A check in the amount of \$330.00 to cover the foregoing fees; and

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AMAZON.012A1



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : Bezos, et al.) Group Art Unit: 3625
Appl. No. : 09/377,447)
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For : Computer Services for Assisting)
Users in Locating and)
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Electronic Catalog based on)
Actions Performed by Members)
of Specific User Communities)
Examiner : James Zurita)

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SUPPLEMENTAL APPEAL BRIEF

Board of Patent Appeals and Interferences
Washington, D.C. 20231

Dear Sir:

This Supplemental Appeal brief is being submitted in accordance with 37 C.F.R. 1.193(b)(2)(ii), together with a Request for Reinstatement of Appeal, to address the new grounds for rejection raised in the Office Action mailed on February 12, 2004.

Appellants hereby incorporate by reference the following sections from their original Appeal Brief:

- I. Real Party in Interest
- III. Status of the Claims
- IV. Status of Amendments
- V. Summary of the Invention
- VII. Grouping of Claims
- VIIIA. Explanation of separate patentability of claim groups

Appendices

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A. RELATED APPEALS AND INTERFERENCES (UPDATED)

An appeal is now pending in U.S. Appl. 09/377,322, filed August 19, 1999, which was filed concurrently with and contains substantially the same disclosure as the present application.

B. SUMMARY OF OFFICE ACTION

In the Office Action mailed on February 12, 2004 (hereinafter "the Office Action"), the Examiner withdrew the obviousness rejections of the pending claims over Anderson (U.S. Patent No. 5,974,396) in view of Bieganski (U.S. Patent No. 6,321,221), and in further view of Robinson (U.S. Patent No. 5,790,426), but asserted new grounds for rejecting the pending claims on obviousness grounds. The claims now stand rejected as follows:

- Claims 1-25, 37 and 38 are rejected over Herz (U.S. Patent 6,460,036) in view of an article titled "Varied collaborative approaches entice intranet users" (hereinafter "Network World").
- Claims 32-36, which are not included in this appeal, are rejected over Herz.
- Claims 26-31 and 39-42 are rejected over Herz in view of an article by Gerald O'Connor titled "New Pitch."
- Claims 43-50 are rejected over Herz in view of an article by Jennifer Lach titled "Reading Your Mind, Reaching Your Wallet" (hereinafter "American Demographics"), and further in view of an article by Karen Angel titled "Are independents making a comeback?" (hereinafter "Publishers Weekly").
- Claims 51-54, 56 and 57 are rejected over Herz in view of New Pitch, and further in view of an article titled "Understanding the bond of identification..." (hereinafter "Journal of Marketing").

As some of the aforementioned references were published less than one year before Applicants' priority date, Applicants reserve the right to disqualify one or more references as prior art in the future.

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C. CLAIM GROUPINGS

Appellants wish to maintain the claim groupings set forth in the original Appeal Brief, as summarized below:

Group 1: Claims 1-25
Group 2: Claims 26-31
Group 3: Claims 51, 54, 56 and 57
Group 4: Claim 52
Group 5: Claim 53
Group 6: Claim 43-50

Claims 32-42 remain omitted from this appeal.

D. ISSUES PRESENTED ON APPEAL

The following issues are presented:

Whether Claims 1 and 12, which are the sole independent claims in Group 1 (Claims 1-25), are properly rejected on obviousness grounds over Herz in view of Network World;

Whether Claim 26, which is the sole independent claim in Group 2 (Claims 26-31), is properly rejected on obviousness grounds over Herz in view of New Pitch;

Whether Claim 51, which is the sole independent claim in Group 3 (Claims 51, 54, 56 and 57), is properly rejected on obviousness grounds over Herz in view of New Pitch, and further in view of Journal of Marketing.

Whether Claim 52, which is the sole claim in Group 4, is properly rejected on obviousness grounds over Herz in view of New Pitch, and further in view of Journal of Marketing;

Whether Claim 53, which is the sole claim in Group 5, is properly rejected on obviousness grounds over Herz in view of New Pitch, and further in view of Journal of Marketing; and

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Whether Claim 43, which is the sole independent claim in Group 6 (Claims 43-50), is properly rejected on obviousness grounds over Herz in view of American Demographics, and further in view of Publishers Weekly.

E. ARGUMENT

Appellants respectfully submit that the obviousness rejections of Groups 1-6 are improper for the reasons set forth below.

1. DISCUSSION OF NEW REFERENCES RELIED ON BY EXAMINER

Herz, Network World, New Pitch, Journal of Marketing, American Demographics, and Publishers Weekly (collectively "the applied references") fail to collectively or individually disclose many of the inventive features that are relevant to this appeal. For example, none of the applied references suggests notifying electronic catalog users of relationships detected between specific items and communities, as set forth in many of the claims, to assist users in selecting items from the electronic catalog. In this regard, the applied references fail to recognize that users can make more informed item selection decisions if they are exposed to such information.

The applied references also fail to suggest a process for identifying those items that distinguish the particular community from a general user population (e.g., as the result of the items being much more popular within the community than within the general user population), as set forth in some of the claims. The applied references also fail to suggest using either email addresses or shipping addresses of users to identify the subsets or communities of users, as set forth in certain claims.

Each reference is discussed in further detail below.

a. Herz (U.S. Patent No. 6,460,036)

Herz discloses methods for identifying target objects, such as news articles, that are likely to be of interest to a target user given a profile of that user. These methods involve generating a target profile for each object, and generating an interests profile for each user. The target profile for an object includes attributes of the object, such as the frequency with which certain words appear in the object, or the circulation level of the object. To determine whether a given target object is likely to be of interest to a given user, Herz uses specific algorithms to determine the

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similarity between a profile of the target object and the profiles of target objects for which the user (or a similar user) has given positive feedback. See col. 6, lines 15-20.

One embodiment of the Herz invention is a news clipping service that predicts which articles are likely to be of interest to a user given the articles the user has previously selected to read. This embodiment is described beginning at col. 55, line 41, and is also described in the context of selecting advertisements and coupons to present to users.

Herz also discloses various techniques for the formation and use of “virtual communities” to facilitate the exchange of messages between users. See columns 74-79 of Herz. These techniques generally involve (1) clustering together messages that are similar, (2) identifying a group of users (referred to as a “pre-community”) who are most likely to be interested in a given cluster of messages, or who otherwise share common interests, (3) determining whether a virtual community already exists that corresponds to the pre-community, (4) sending email messages to the pre-community members inviting them to join an existing or a new virtual community, and (5) scanning new messages to identify messages that correspond to the profile or common interests of a given virtual community, so that copies of these messages may be provided to the virtual community.

b. Network World

Network World discloses various new and existing collaboration tools for facilitating information filtering and retrieval on intranets. Although the Office Action states that Claims 1-25 (Group 1) are rejected over Herz *in view of Network World*, the Examiner apparently did not rely on Network World in rejecting either of the two independent claims in Group 1. Consequently, Network World apparently is not relevant to any of the issues on appeal.

c. New Pitch

New Pitch discloses techniques for providing targeted advertising to World Wide Web users. One such marketing technique involves the use of email addresses to select users who are to receive advertisements. For example, the article states that a maker of a luxury car might try to reach users from commercial domains of Fortune 1000 companies who have requested high-end technical information. The article also discloses the real-time generation of web pages that take into account the usage patterns of users.

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d. Journal of Marketing

Journal of Marketing discusses a study that was conducted regarding the tendency of consumers to identify with specific companies and other organizations, such as those that support specific causes (e.g., Ben & Jerry's support of rainforests). The article also discusses the importance of such consumer identification to brand loyalty and customer retention.

e. American Demographics

American Demographics describes recommendation techniques used by certain web sites to recommend items to users. A portion of this article relied on by the Examiner describes the use of a survey to collect home addresses and entertainment interests of consumers. This information is used to inform consumers of events, such as concerts, within their respective regions, and to provide collaborative recommendations to such consumers.

f. Publishers Weekly

Publishers Weekly is an article about how independent bookstores are making a comeback. The article briefly mentions the New York Times bestseller list.

Although the Office Action states that Claims 43-50 (Group 6) are rejected over Herz in view of American Demographics *and further in view of Publishers Weekly*, the Examiner apparently did not rely on Publishers Weekly in rejecting Claim 43. Consequently, Publishers Weekly apparently is not relevant to any of the issues on appeal.

2. DISCUSSION OF THE ISSUES ON APPEAL

As set forth below, the obviousness rejections of Groups 1-6 are improper because (a) the applied references do not disclose or suggest all of the claim limitations of the broadest claim(s) of each claim group, and (b) the applied references do not suggest the desirability of the claimed invention.

a. The applied references do not disclose or suggest all of the claim limitations of the broadest claim(s) of each claim group.

In order to establish prima facie obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. See MPEP § 2143.03. In this case, the applied references fail to satisfy this requirement with respect to the broadest claim or claims of each claim group. Each claim group is discussed separately below.

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Group 1

Group 1 consists of independent Claims 1 and 12 and their respective dependent claims (collectively Claims 1-25). If the obviousness rejections of independent Claims 1 and 12 are improper, then the obviousness rejections of the dependent claims in Group 1 are also improper. Appellants will therefore only address the rejections of independent Claims 1 and 12, which are reproduced below.

1. A method of assisting users in selecting items from an electronic catalog of items, the catalog accessible to users of an online sales system that provides services for allowing users to purchase items from the catalog, the method comprising:

providing a database which contains information about a plurality of user communities, wherein different communities represent different subsets of users of the sales system;

tracking online purchases of items from the sales system by the users to generate purchase history data, and storing the purchase history data in a computer memory;

processing at least the purchase history data to identify at least one item which, based on actions of both members and non-members of a selected community of said plurality of user communities, has a popularity level that is substantially greater within the selected community than outside the selected community; and

electronically notifying users that the at least one item is popular within the selected community to assist users in selecting items from the electronic catalog.

12. A system for assisting users of an online sales system in selecting items from an electronic catalog of items, the system comprising:

at least one database which contains purchase history data for users of the sales system, and which contains information about a plurality of user communities wherein different communities represent different subsets of users of the sales system; and

a computer process which analyzes at least the purchase history data to identify items that have substantially higher popularity levels within particular communities of the plurality of communities relative to their respective popularity levels among a general user population, and which notifies users of the sales system of the items and associated communities for which such popularity level disparities exist, to thereby assist such users in selecting items from the electronic catalog.

As mentioned above, although the Office Action indicates that Claims 1 and 12 are rejected as being unpatentable over Herz in view of Network World, the Examiner appears to

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rely solely on Herz in rejecting these two claims. Appellants will therefore limit their discussion to Herz.

In rejecting Claim 1, the Examiner takes the position that Herz discloses “processing at least the purchase history data to identify at least one item which, based on actions of both members and non-members of a selected community of said plurality of user communities, has a popularity level *that is substantially greater within the selected community than outside the selected community*” (emphasis added). Appellants disagree. The portions of Herz relied on by the Examiner indicate that the popularity level or circulation of some types of objects may be determined (see col. 12, lines 25-29), and may be incorporated into an algorithm for matching objects to users (see paragraph beginning at column 18, line 49). Nothing in these cited portions of Herz, or any other portion of Herz, suggests analyzing purchase history—or any other type of history data—to identify an item having a popularity level that is substantially greater within a selected community than outside the selected community. In this regard, the object targeting methods disclosed in Herz do not rely on a popularity disparity analysis of the type set forth in Claim 1.

This deficiency in Herz is also pertinent to Claim 12, which recites “a computer process which analyzes at least the purchase history data to identify items that have substantially higher popularity levels within particular communities of the plurality of communities relative to their respective popularity levels among a general user population.” Nothing in Herz suggests a computer process that performs this type of popularity disparity analysis.

Herz also fails to disclose or suggest the notification function set forth in Claims 1 and 12. Specifically, regarding Claim 1, Herz does not disclose or suggest “electronically notifying users that the at least one item is popular within the selected community to assist users in selecting items from the electronic catalog.” With respect to Claim 12, Herz fails to disclose or suggest a computer process which notifies users “of the items and associated communities for which such popularity level disparities exist, to thereby assist such users in selecting items from the electronic catalog.”

In connection with these notification-related limitations, the Examiner relies on the disclosure in Herz regarding the delivery of messages, such as bulletin board messages, to members of virtual communities. See columns 74-79 of Herz. This portion of Herz discloses various methods for (1) clustering together messages that are similar, (2) identifying a group of

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users (referred to as a “pre-community”) who are most likely to be interested in a given cluster of messages, or who otherwise share common interests, (3) determining whether a virtual community already exists that corresponds to the pre-community, (4) sending email messages to the pre-community members inviting them to join an existing or a new virtual community, and (5) scanning new messages to identify messages that correspond to the profile or common interests of a given virtual community, so that copies of these messages may be provided to the virtual community. Nothing in the virtual communities disclosure of Herz suggests that the users are notified that an item is popular within a particular community (Claim 1), or are notified of the items and associated communities for which popularity level disparities exist (Claim 12). The Examiner’s assertion that it would have been obvious to extend Herz to provide such notifications is not supported by the disclosure of Herz or by the other applied references.

Regarding the phrase “to assist users in selecting items from the electronic catalog” in Claim 1, and the phrase “to thereby assist such users in selecting items from the electronic catalog” in Claim 12, the Examiner acknowledges that these limitations are not specifically disclosed by Herz. See Office Action at page 6, first paragraph. The Examiner appears to take the position, however, that these phrases are merely non-limiting statements of intended use. Appellants disagree. In both cases, the phrases are limiting in that they (1) require the recited “items” to be items that are selectable from an electronic catalog, and (2) require the notifications to be provided in a form that assists users in making selections from the electronic catalog. In addition to further defining the invention, these limitations provide a distinction over the virtual communities disclosure in Herz, in which the objects (messages) apparently are not items that are selectable from “an electronic catalog.” The cases cited by the Examiner do not support the Examiner’s position that the phrases quoted above are merely statements of intended use.

Because Herz fails to disclose or suggest all of the limitations of Claims 1 and 12, the rejections of the Group 1 claims are improper.

Group 2

Group 2 consists of independent Claim 26 and its dependent claims (collectively Claims 26-31). Claim 26 is directed to an embodiment in which email addresses of users are used to identify a subset of users. The claim reads as follows:

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26. A method of assisting users in selecting items from an electronic catalog of items, the catalog accessible to users of an online sales system that provides services for allowing users to purchase items from the catalog, the method comprising the computer-implemented steps of:

identifying a subset of users of the store that have email addresses that satisfy a particular criteria, wherein the subset comprises a plurality of users;

identifying at least one item that characterizes the subset of users, wherein the step of identifying comprises processing purchase history data of the subset of users and of users falling outside said subset; and

electronically notifying users of the online sales system of a relationship between the at least one item and the subset of users, to assist users in selecting items from the electronic catalog.

Although the Office Action indicates that Claim 26-31 are rejected over Herz in view of New Pitch, the Examiner appears to rely solely on Herz in rejecting Claim 26. Appellants will therefore limit their remarks regarding Claim 26 to Herz.

In rejecting Claim 26, the Examiner takes the position that Herz discloses the step of “identifying at least one item that characterizes the subset of users [that have email addresses that satisfy a particular criteria], wherein the step of identifying comprises processing purchase history data of the subset of users and of users falling outside said subset.” Appellants disagree. The cited portion of Herz involving the news clipping service (beginning at column 55, line 41) discloses various methods for matching news articles to users who are likely to be interested in such articles. These methods do not involve the identification of an item that characterizes a subset of users as set forth in Claim 26. The disclosure from column 72, line 10 to column 78, line 8 also fails to disclose or suggest this feature.

This deficiency in Herz is particularly evident when viewed in light of the requirement that the “subset of users” be a subset of users that have email addresses satisfying a particular criterion. Nothing in the news clipping service or virtual communities sections of Herz suggests this feature. Although other portions of Herz mention the use of email communications for various purposes, nothing in Herz suggests identifying a subset of users having email addresses satisfying a particular criterion in the context of identifying an item that characterizes that subset.

Herz also fails to disclose or suggest the step of “electronically notifying users of the online sales system of a relationship between the at least one item and the subset of users, to assist users in selecting items from the electronic catalog.” In connection with these limitations,

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Appellants respectfully disagree with the Examiner's apparent assertion that Herz discloses, at column 30, lines 27-39, "electronic notification of the relationship between target objects and user virtual communities." The reference to "consumer/product relationships" in this section of Herz is not an indication that users are notified of a relationship between an item and a virtual community. Applicants also disagree that the recited electronic notification step is disclosed at column 78, line 43 to column 79, line 43 and column 58, line 25 to column 59, line 8 of Herz.

Finally, Appellants disagree with the Examiner's apparent assertion that the phrase "to assist users in selecting items from the electronic catalog" in Claim 26 is non-limiting. As with Claims 1 and 12, this phrase is not merely a statement of intended use. As the Examiner acknowledges that Herz does not specifically disclose providing the notifications "to assist users in selecting items from the electronic catalog," this feature of Claim 26 provides an additional distinction over Herz.

Because Herz fails to disclose or suggest all of the limitations of Claim 26, the rejections of the Group 2 claims are improper.

Group 3

Group 3 consists of independent Claim 51 and corresponding dependent Claims 53, 56 and 57. Claim 51 is reproduced below, with reference characters added for purposes of discussion.

51. A computer-implemented method of assisting users in selecting items from an electronic catalog of items, the method comprising:

- (a) storing email addresses of users of the electronic catalog;
- (b) for each of a plurality of organizations, identifying a respective group of said users who are deemed to be affiliated with the respective organization by virtue of a domain name of the respective organization occurring within an email address of each such user, to thereby identify a plurality of organization-specific groups of users;
- (c) tracking at least one type of user activity that indicates user affinities for particular items in the electronic catalog to generate activity history data for the users;
- (d) for each organization-specific group of users, analyzing the activity history data to generate a list of items within the electronic catalog that distinguish the organization-specific group from a general population of the users, to thereby generate a plurality of organization-specific popular items lists; and
- (e) exposing the organization-specific popular items lists to the users of the electronic catalog in association with the organizations to which such popular items

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lists correspond, to allow users to identify items that are popular within specific organizations.

The Examiner rejected Claim 51 on obviousness grounds over Herz in view of New Pitch, in further view of Journal of Marketing. Appellants submit that the rejection is improper because, among other reasons, Herz, New Pitch and Journal of Marketing do not disclose or suggest the limitations subparagraphs (b), (d) and (e) in the context of the other claim limitations.

Subparagraphs (b) and (d) of Claim 51

Regarding subparagraph (d), the Examiner takes the position that Herz discloses some, but not all, of the recited limitations. Specifically, the Examiner takes the position that Herz teaches “analyzing the activity history data to generate a list of items within the electronic catalog that distinguish the ... group from a general population of the users.” Appellants disagree. The portions of Herz relied on by the Examiner do not disclose or suggest such a process, but rather disclose techniques for clustering similar objects, and for matching objects to users. As discussed above, the primary method disclosed in Herz for matching objects to users involves specific algorithms for determining the similarity between a profile of a target object and the profiles of target objects for which the target user, or a similar user, has provided positive feedback. See col. 6, lines 15-20 of Herz. Nothing in this process, or in any of the other processes disclosed in Herz, involves identifying catalog items that distinguish a group of users from a general population of users as set forth in subparagraph (d).

Regarding the other limitations of subparagraph (d), and specifically those requiring that each “group of users” be an “organization-specific group of users” identified using email addresses as set forth in subparagraph (b), the Examiner relies on New Pitch. Specifically, the Examiner relies on the teaching in New Pitch to send advertisements to users in a particular domain, such as the “.edu” domain or the commercial domains of Fortune 1000 companies, who have requested a particular type of information. See Office Action at page 36, first full paragraph. Appellants submit that the Examiner’s reliance on New Pitch is misplaced. First, New Pitch does not disclose identifying a plurality of organization-specific groups of users as set forth in subparagraph (b).

Second, as with Herz, the cited portion of New Pitch is not directed to the problem of identifying catalog items that are popular among, or which distinguish, a particular group of users.

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Thus, even if New Pitch could be construed as suggesting the identification of organization-specific groups of users as in subparagraph (b), one skilled in the art would not be motivated to combine this teaching with the disclosure of Herz to identify lists of catalog items that distinguish specific organization-specific groups of users from a general user population.

In connection with this issue, the Examiner takes the position that it would be obvious to combine Herz and New Pitch so that “one may obtain information about what is being read at those companies.” Office Action at page 37, lines 14 and 15. This asserted motivation to combine does not, however, appear to come from Herz, New Pitch, or any of the other cited references.

To the extent the Examiner may be relying on *Journal of Marketing* as providing a motivation to combine Herz and New Pitch (see Office Action at page 37, six lines from bottom), Appellants submit that no such motivation is provided. The cited passage of *Journal of Marketing* (page 3, paragraph 3) discusses how people who identify with specific organizations, such as those who are employees or alumni of such organizations, tend to be more loyal to their respective organizations. Neither this passage nor any other portion of *Journal of Marketing* suggests combining the teachings of Herz and New Pitch.

Subparagraph (e) of Claim 51

Regarding subparagraph (e), the Examiner takes the position that Herz discloses some, but not all, of the recited limitations. Specifically, the Examiner takes the position that Herz teaches exposing group-specific popular items lists to users of an electronic catalog in association with the groups to which such popular items lists correspond, to allow users to identify items that are popular within specific groups. Office Action at page 34, section (h). Appellants disagree. The sections of Herz cited by the Examiner do not involve or suggest the exposure of group-specific popular items lists to users of an electronic catalog as set forth in subparagraph (e).

Regarding the remaining limitations of subparagraph (e), and specifically those requiring the popular items lists to be “organization-specific,” the Examiner appears to rely again on New Pitch. As explained above, however, New Pitch is not directed to the problem of identifying, or notifying users of, items that are popular within or which distinguish specific organizations. Thus, the Examiner’s apparent reliance on *New Pitch* in connection with subparagraph (e) is misplaced.

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Group 4

Group 4 consists of dependent Claim 52. Claim 52 depends from Claim 51, and is therefore patentable over the applied references for the reasons set forth above for Group 3.

In addition, Claim 52 recites the additional feature of “providing to a target user a personalized web page that displays organization-specific popular items lists of organizations with which the target user is affiliated.” A preferred embodiment of this feature is illustrated in Figure 2 of the present application. The applied references do not disclose or suggest this feature.

The Examiner takes the position that the limitations of Claim 52 are disclosed by Herz and New Pitch. See Office Action at page 38, first full paragraph. Appellants disagree. As explained above, neither reference discloses or suggests displaying organization-specific popular items lists to users. The portion of New Pitch cited by the Examiner, namely page 55, center column, last two paragraphs, does not disclose or suggest this feature, but rather describes generally how web pages may be generated in real time to provide targeted marketing to users.

Because the applied references do not disclose or suggest all of the limitations of Claim 52, the rejection of Claim 52 is improper.

Group 5

Group 5 consists of dependent Claim 53, which depends from Claim 51. The rejection of Claim 53 is improper for the reasons set forth above for Group 3.

In addition, Claim 53 recites the additional feature of substantially excluding from consideration activity history data falling outside a selected look-back period. This feature allows the organization-specific popular items lists to be generated or updated based primarily on a most recent set of activity data, so that the lists tend to reflect the current interests of users.

In connection with this feature, the Examiner again relies on Herz and New Pitch, citing a portion of New Pitch which says that the content of web pages generated in real time “may be based on lookups to outside data sources or historical usage patterns that may go back months, years, or just minutes.” This cited portion of New Pitch appears to refer to the look-up of preference or usage pattern information about the particular user for whom the web page is being generated, so that the web page can be appropriately customized for that user. Nothing in this portion of New Pitch, or any other portion of the applied references, suggests “substantially excluding from

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consideration activity history data falling outside a selected look-back period” within the context of an analysis of the type set forth in Claim 51, subparagraph (d).

As none of the applied references discloses or suggests this feature, the limitations added by Claim 53 provide an additional basis for patentability.

Group 6

Group 6 consists of independent Claim 43 and its dependent claims (collectively Claims 43-50). Claim 43 is directed to an embodiment in which user shipping addresses are used to identify a subset of users. The claim reads as follows, with reference characters added for purposes of discussion:

43. A method of assisting users in selecting items from an electronic catalog of items, comprising:

(a) identifying, among a population of users of the electronic catalog, a subset of users that, based on user shipping addresses, reside in a common geographic region;

(b) monitoring actions of the subset of users, and of users falling outside the subset, to generate user activity history data reflective of user actions performed with respect to items in the electronic catalog;

(c) processing the user activity history data to identify an item whose popularity level among the subset of users is substantially higher than a popularity level of the item among the population of users; and

(d) notifying at least one user that a relationship exists between the item and the geographic region to assist the at least one user in selecting items from the electronic catalog.

Although the Office Action states that Claims 43-50 are rejected over Herz, American Demographics, and *Publishers Weekly*, the Examiner apparently did not rely on *Publishers Weekly* in rejecting Claim 43. Appellants will therefore treat Claim 43 as being rejected over Herz and American Demographics.

The Examiner takes the position that Herz discloses the limitations of subparagraph (c), citing column 34, line 9 to column 35, line 43 of Herz. Appellants disagree. The cited portion of Herz describes how proxy servers may be used to conceal the identities of users, so that the profiles of these users need not be exposed to other entities. Nothing in this, or any other, portion of Herz discloses processing user activity history data to identify an item whose

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popularity level among the subset of users is substantially higher than a popularity level of the item among the population of users.

With respect to subparagraph (d), Appellants disagree with the Examiner's position that the language "to assist the at least one user in selecting items from the electronic catalog" is non-limiting. This language further distinguishes the claimed subject matter from the applied art, and is not merely a non-limiting statement of intended use. Appellants also disagree with the Examiner's conclusion that Herz and American Demographics suggest "notifying at least one user that a relationship exists between the item and the geographic region" within the context of the other claim limitations.

Finally, Appellants submit that Herz and American Demographics do not suggest the method of Claim 43 as a whole. In this regard, neither reference suggests using activity data and shipping addresses of users to identify an item having a substantially higher popularity level among users in a particular geographic region, in combination with notifying a user that a relationship exists between the item and the geographic region to assist the user in making a selection from the catalog. In this regard, the cited portion of American Demographics suggests the use of home address information for a very different purpose, namely to notify users of events within their respective locations.

Because Herz and American Demographics do not disclose or suggest all of the limitations of Claim 43, the rejections of the Group 6 claims are improper.

b. The applied references do not suggest the desirability of the claimed invention.

As set forth in MPEP 2143.01, in order to establish obviousness based on a combination of references, the prior art must suggest the desirability of the claimed combination. "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." MPEP 2143.01 (emphasis original).

In the present case, all of the independent claims include language related to the function of notifying electronic catalog users of a relationship between a catalog item and a user group or community. As discussed above, this aspect of the invention is desirable as it assists users in

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making more informed item selection decisions (e.g., by allowing users to identify items that have gained acceptance within specific companies, organizations, geographic locations, etc.). The applied references do not suggest this desirability, but rather focus primarily on identifying items to recommend or promote to users.

Because the applied references fail to suggest the desirability of the claimed invention, the rejections of the claims of Groups 1-6 are improper.

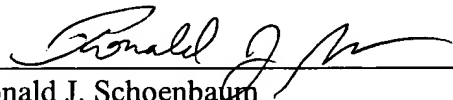
F. CONCLUSION

For the reasons set forth above, Appellants submit that the rejections of the claims of Groups 1-6 are improper, and request that these rejections be reversed.

Respectfully submitted,

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